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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/169,351 10/09/98 CORBITT J P/3120-9

002352 QM12/1217
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EXAMINER

JACKSON, S

ART UNIT

PAPER NUMBER

3738

DATE MAILED:

12/17/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/169,351

Applicant(s)

Corbitt, Jr. et al.

Examiner

Suzette Jackson

Group Art Unit

3738

☒ Responsive to communication(s) filed on Oct 9, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-5 and 7-15 is/are rejected.

☒ Claim(s) 6 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Oct 9, 1998 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title of Breast Implant is vague and non-descriptive among the many varying "Breast Implants". Suggestions: "Bioabsorbable Breast Implant".

Drawings

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show element "8" and "4" in Figure 3 as mentioned on page 5, line 7 of the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 7 recites the broad recitation "capable of carrying substances", and the claim also recites "such as radiation material, antibiotics,....." which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claims 1, 2, 5, 7, 10, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Liu et al. USPN 5,626,611 comprising the invention *as claimed* including: An implant for implantation in a human body comprising an outer shell (30, 35 38) of a resorbable material; capable of carrying other substances; the implant being formed to fit the shape and size of a cavity in the human body (col. 6, lines 66-67), the implant supporting tissue surrounding the cavity upon implantation and allowing for in-growth of fibrous tissue into and replacing the outer shell (col. 4, line 7-10).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3, 8, 9, 12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al. which has been disclosed above yet not specifying or limiting to a particular medical device. It would have been obvious to one having ordinary skill in the art at the time the

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invention was made that if the invention of Liu was formulated into a stent or graft (col.6, lines 66-2) that it would be elastically compressible into to fit into the cavity it is formulated for and it is also obvious that collagen, and amino acids are "therapeutic or diagnostic substances (col.4, lines 42-43).

9. Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu in view of McGregor et al. 5,86,080. Liu has been disclosed above however McGregor teaches that use of absorbable material having a foam structure has been utilized in the past by EPA0274898. It would have been obvious to one having skill in art to utilize absorbable foam material to allow for ingrowth of new healthy tissue to the wound site.

Allowable Subject Matter


10. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

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11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. 5,522,896 Prescott; 5,922,024 Janzen et al.; 35,391 Brauman; 5,824,081 Knapp et al.; all show related art.

12. Any inquiry concerning this communication or earlier communication regarding this application should be directed to examiner Suzette Jackson at (703) 308-6516. If you are unable to reach me, please contact my supervisor, Mickey Yu, at (703) 308-2672. In a case requiring immediate assistance, please call (703) 308-0858 to reach the main operator for Sector 3700.


S. Jackson
13 December 1999


David H. Willse
Primary Examiner